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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,673	09/25/2003	Bruce K. Wachtmann	2550/185	6398
2101	7590	05/18/2005		
BROMBERG & SUNSTEIN LLP 125 SUMMER STREET BOSTON, MA 02110-1618			EXAMINER PIZARRO CRESPO, MARCOS D	
			ART UNIT	PAPER NUMBER
			2814	

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

875

Office Action Summary	Application No. 10/670,673	Applicant(s) WACHTMANN, BRUCE K.	
	Examiner Marcos D. Pizarro-Crespo	Art Unit 2814	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 9-14 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 15-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/21/05, 9/25/03</u> | 6) <input type="checkbox"/> Other: _____ |

Attorney's Docket Number: 2550/185

Filing Date: 9/25/2003

Claimed Priority Date: 12/3/2002 (CIP of 10/308,688)

Applicant(s): Wachtmann

Examiner: Marcos D. Pizarro-Crespo

DETAILED ACTION

This Office action responds to the election filed on 5/4/2005.

Election/Restrictions

1. Applicant's election without traverse of claims 1-8 and 15-19 in the reply filed on 5/4/2005 is acknowledged. Claims 9-14 and 20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 5 recites the limitation "additional conductive path" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-8 and 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Barron (US 5919548).

7. Regarding claim 1, Barron (see, e.g., figs. 3a-4c) shows all aspects of the instant invention including a method of forming a surface micromachined MEMS device, the method comprising:

- ✓ Providing a substrate **10**
- ✓ Applying an insulator **16** on the substrate **10**
- ✓ Depositing a conductive path **20** on the insulator **16**

wherein:

- ✓ The conductive path **20** is capable of transmitting an electronic signal between two points on the MEMS device (see, e.g., col.7/ll.46)
- ✓ The insulator **16** electrically isolates the conductive path **20** from the substrate
- ✓ The MEMS device is free of semiconductor junctions formed between the substrate **10** and the conductive path **20** (see, e.g., fig. 3c)

8. Regarding claim 2, Barron shows the method further comprising:

- ✓ Forming circuitry **300** and structure **200**, the circuitry **300** and structure **200** being the two points (see, e.g., fig. 4c)

- ✓ Connecting the conductive path **20** between the circuitry **300** and the structure **200** (see, e.g., fig. 4c)

9. Regarding claims 3 and 16, Barron shows the structure is electrically isolated from the substrate (see, e.g., fig. 4c).

10. Regarding claims 4 and 18, Barron shows the method further comprising:

- ✓ Applying an additional insulator **24** above the conductive path **20**
- ✓ Depositing an additional conductive path **38** on the additional insulator **24**

wherein the conductive path **20** and the additional conductive path **38** are in different planes of the MEMS device **200** (see, e.g., fig. 4c).

11. Regarding claim 5, Barron shows the method further comprising electrically connecting the conductive path **20** and the additional conductive path **38** with a connector **44**, the connector **44** being one of a via and a staple (see, e.g., fig. 4c).

12. Regarding claim 6, Barron shows the insulator **16** spacing the conductive path **20** from the substrate **10** (see, e.g., fig. 3d).

13. Regarding claim 7, Barron shows the substrate **10** is free of embedded electrodes (see, e.g., fig. 3a).

14. Regarding claim 8, Barron shows the conductive path **20** comprising polysilicon (see, e.g., col.7/ll.46).

15. Regarding claim 15, Barron shows (see, e.g., figs. 3a-4c) all aspects of the instant invention including a method of forming a sensor, the method comprising:

- ✓ Forming an insulator on a substantially intrinsic semiconductor substrate **10**
- ✓ Forming a conductive path **20** on the insulator **16**

- ✓ Forming circuitry **300** and structure **200**
- ✓ Connecting the conductive path **20** between the circuitry **300** and the structure **200**

wherein:

- ✓ The insulator **16** and the conductive path **20** are formed by surface micromachining processes (see, e.g., col.7/ll.59-67, col.12/ll.7-10)
- ✓ The insulator **16** electrically isolates the conductive path **20** from the substrate (see, e.g., fig. 4a)
- ✓ The conductive path **20** is capable of transmitting an electronic signal between the circuitry **300** and the structure **200** (see, e.g., col.7/ll.45-49)

16. Regarding claim 17, Barron shows the MEMS device is free of semiconductor junctions between the substrate **10** and the conductive path **20** (see, e.g., fig. 4a).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barron in view of Fladre (US 2004/0152272).

19. Regarding claim 19, Barron shows most aspects of the instant invention (see, e.g., paragraph 15 above). Barron also teaches that the insulator is an oxide having a

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thickness of about .06 μm (see, e.g., col.7/ll.30-32) but fails to show the claimed thickness of .15 to 1.5 μm . However, differences in thickness will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such differences are critical. "Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the workable ranges by routine experimentation". *In re Aller*, 220 F.2d 454,456,105 USPQ 233, 235 (CCPA 1955). Along these lines, Fladre teaches (see, e.g., par. 0050) that the larger the thickness of Barron's oxide layer is, the more the parasitic capacitance between the conductive path and the substrate will be reduce. The original thickness of Fladre's oxide layer ranges from .400 to 1.000 μm (see, e.g., par. 0048).

Based on the teachings of Fladre, the specific claimed thicknesses, are only considered to be the "optimum" thicknesses disclosed by Barron that a person having ordinary skill in the art would have been able to determine using routine experimentation based, among other things, on the desired reduction in parasitic capacitance, manufacturing costs, etc. (see Boesch, 205 USPQ 215 (CCPA 1980)), and since neither non-obvious nor unexpected results, *i.e.*, results which are different in kind and not in degree from the results of the prior art, will be obtained as long as an oxide insulator separates the conductive path from the substrate, as already suggested by Barron.

Accordingly, since the applicants have not established the criticality (see next paragraph below) of the stated thicknesses and since these thicknesses have been in common use in similar devices in the art, as shown by Fladre, it would have been obvious to one of ordinary skill in the art to use these values in the method of Barron.

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CRITICALITY

20. The specification contains no disclosure of either the critical nature of the claimed thicknesses or any unexpected results arising therefrom. Where patentability is said to be based upon particular chosen dimensions or upon another variable recited in a claim, the applicant must show that the chosen dimensions are critical. *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Conclusion

21. Papers related to this application may be submitted directly to Art Unit 2814 by facsimile transmission. Papers should be faxed to Art Unit 2814 via the Art Unit 2814 Fax Center. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (15 November 1989). The Art Unit 2814 Fax Center number is **(703) 872-9306**. The Art Unit 2814 Fax Center is to be used only for papers related to Art Unit 2814 applications.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Marcos D. Pizarro-Crespo** at **(571) 272-1716** and between the hours of 9:30 AM to 8:00 PM (Eastern Standard Time) Monday through Thursday or by e-mail via Marcos.Pizarro@uspto.gov. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy, can be reached on (571) 272-1705.

23. Any inquiry of a general nature or relating to the status of this application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair->

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direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

24. The following list is the Examiner's field of search for the present Office Action:

Field of Search	Date
U.S. Class / Subclass(es): 438/52, 453	5/12/2005
Other Documentation: PLUS Analysis	5/12/2005
Electronic Database(s): EAST (USPAT, EPO, JPO)	5/12/2005


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MDP/mdp
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